



UNITED STATES PATENT AND TRADEMARK OFFICE

Ed

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,602	03/17/2004	Jean-Louis Gerstenmayer	034299-000571	7379

7590 07/06/2005

Robert E. Krebs
Thelen Reid & Priest, LLP
P.O. Box 640640
San Jose, CA 95164-0640

EXAMINER

HANNAHER, CONSTANTINE

ART UNIT PAPER NUMBER

2878

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/803,602	GERSTENMAYER ET AL.	
	Examiner	Art Unit	
	Constantine Hannaher	2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-18 is/are rejected.
- 7) ☒ Claim(s) 8 and 19-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/069,045.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040317</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION**Information Disclosure Statement**

1. As set forth in MPEP § 609:

37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. U.S. patents must be identified by the inventor, patent number, and issue date. U.S. patent application publications must be identified by the applicant, patent application publication number, and publication date. U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date. If a U.S. application being listed in an IDS has been issued as a patent, the applicant should list the patent in the IDS instead of the application. Each foreign patent or published foreign patent application must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication must be identified by publisher, author (if any), title, relevant pages of the publication, date and place of publication. The date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue. The place of publication refers to the name of the journal, magazine, or other publication in which the information being submitted was published.

Oath/Declaration .

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It is not plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent, as required under 37 CFR 1.52(a)(1)(iv).

3. When applicant states that the post office address is the "same" as residence applicant's representative should keep in mind that a "residence" is a city and state or foreign country. The superfluous information given for residence is accepted as constituting a mailing address. The Office

has **NOT** been able to discern the city and state or foreign country of residence from the information supplied. See the requirements of 37 CFR 1.63(c)(1) as amended effective November 7, 2000.

Specification

4. The status of copending U.S. applications mentioned in the specification, if known, should be updated.

5. Because acceptable units generally have internationally recognized symbols and names, it is not permissible to use abbreviations for their unit symbols or names, such as sec (for either s or second), sq. mm (for either mm² or square millimeter), cc (for either cm³ or cubic centimeter), mins (for either min or minutes), hrs (for either h or hours), lit (for either L or liter), amps (for either A or amperes), AMU (for either u or unified atomic mass unit), or mps (for either m/s or meter per second).

Note the use of the "sec" in claim 3 and page 4, line 20, and elsewhere; note the use of the "gm" in claim 18 and page 5, line 6, and elsewhere. The proper use of the metric system is a requirement of PCT Rule 10.1(a).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 15, 3, 4, 16, 5, 17, 6, 18, 7, 9, 10, 11, 13, 14, and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 9, and 11 of U.S. Patent No. 6,727,503 in view of Schropp *et al.* (EP0917208).

With respect to independent claim 1, this claim differs from claim 1 of the patent in the identification of the layer of semiconducting material as that of a composite with host matrix and guest particles. A semiconducting composite material comprising a host matrix made of a polymer and guest particles of the semiconductor type dispersed throughout the host matrix is known, as shown by Schropp *et al.* In view of the reduced cost of a solid state composition creating an interpenetrating conducting material (semiconducting in view of the listing of known II-VI semiconductors) in a nanoporous network as described by Schropp *et al.*, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the claim to a detector of incident ionizing radiation in the patent to specify that the layers of semiconducting material were a composite of host matrix and guest particles.

With respect to dependent claim 2, the polymer disclosed by Schropp *et al.* is of at least one of the recited group (and thus anticipates that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 15 and 3, the polymer disclosed by Schropp *et al.* has the recited feature (because of the identity of the material and thus anticipates that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claim 4, the polymer disclosed by Schropp *et al.* is one of the recited group (and thus anticipates that element) and it would have been obvious to one of ordinary

skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 16 and 5, the semiconductor particles disclosed by Schropp *et al.* have at least one of the recited features (and thus anticipate that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 17 and 6, the semiconductor particles disclosed by Schropp *et al.* are of at least one of the recited group (and thus anticipate that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claims 18 and 7, the semiconductor particles disclosed by Schropp *et al.* have the recited properties (and thus anticipate that element) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a known feature according to the suggestion of Schropp *et al.*

With respect to dependent claim 9, this claim does not differ from claim 2 of the patent.

With respect to dependent claim 10, this claim does not differ from claim 3 of the patent.

With respect to dependent claim 11, this claim does not differ from claim 4 of the patent.

With respect to dependent claim 13, this claim does not differ from claim 9 of the patent.

With respect to dependent claim 14, this claim does not differ from claim 11 of the patent.

With respect to dependent claim 12, this claim does not differ from claim 5 of the patent.

Response to Submission(s)

8. The amendment filed March 17, 2004 has been entered. These are the same claims which received an action 6 months earlier.

Allowable Subject Matter

9. Claims 19, 8, and 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: although it is presumed that coating to prevent agglomeration of guest particles in a host matrix is a known procedure, Schropp *et al.* does not suggest the step.

11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

12. This is a continuation of applicant's earlier Application No. 10/069,045. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

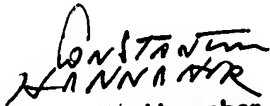
calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ch


Constantine Hannaher
Primary Examiner